



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,412	07/11/2003	Franklin B. Way	996263-2	3482

7590 08/20/2004

Camille L. Urban, Brown, Winick, Graves, Gross,
Baskerville & Schoenebaum PLC
Regency West 5, 4500 Westown Parkway
Suite 277
West Des Moines, IA 50266

EXAMINER

GREEN, BRIAN

ART UNIT PAPER NUMBER

3611

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/617,412

Applicant(s)

WAY, FRANKLIN B.

Examiner

Brian K. Green

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 12, 13, 15, 16, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/11/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION***Drawings***

The drawings are objected to because in figure 2 it appears that the applicant is showing the light source (18) twice, i.e. one of the light sources is marked (18) and the other one does not include a numeral marking and appears directly below the marked light source (18). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the circuit means defined in claim 3, the fluorescent light source defined in claim 5, the securing means defined in claim 11, the adhesive material and plurality of clamping devices defined in

Art Unit: 3611

claims 14 and 19 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 5,10, and 11-20 are objected to because of the following informalities: In claim 5, line 2, “florescent” should be “fluorescent”. In claim 10,line 3, “said means” should be “said transparent protective means” to make it clear that the applicant is referring to the protective means and not the backing means. In claim 11, section (g), lines 1-2, “said at least partially transparent piece” should be “said at least one at least partially transparent piece” and “said generally opaque piece” should be “said at least one

Art Unit: 3611

generally opaque piece”. Appropriate correction is required. In claim 12, lines 2-3, claim 14, line 2, claim 16, lines 2-3 “said at least partially transparent piece” should be “said at least one at least partially transparent piece”. In claim 14, lines 2-3, “said generally opaque piece” should be “said at least one generally opaque piece”. In claim 19, section (b), line 2, section (c), line 2, and section (e), lines 1-2, and claim 20, lines 1-2, “said at least partially transparent art piece” should be “said at least one at least partially transparent art piece”. In claim 19, section (b), line 3, section (e), line 2, and claim 20, line 2, “said generally opaque art piece” should be “said at least one generally opaque art piece”. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3,6,8-11,14, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook (U.S. Patent No. 2,902,787) in view of Wiener (U.S. Patent No. 4,899,473).

Cook shows in figures 1-4 a combination display frame comprising an outside periphery (1), backing means (4), at least two pieces of art (3,3) at least one being substantially transparent, and light means (20). Cook does not disclose the idea of attaching a mat having a plurality of opening therein within the frame. Wiener shows in figure 1 the idea of attaching a mat having a plurality of holes therein, see column 2, lines

Art Unit: 3611

10-12. In view of the teachings of Wiener it would have been obvious to one in the art to modify Cook by attaching a mat having a plurality of opening within the frame since this would create a more aesthetically pleasing display frame assembly. In regard to claim 2, a switch (24) is shown. In regard to claim 3, it is not clear whether the switch is a toggle switch. The use of toggle switches are conventional. It would have been an obvious matter of design choice to make the switch in the form of a toggle switch since the applicant fails to define any advantage achieved by using a toggle switch and the switch used by Cook would work equally well. In regard to claim 6, the backing (4) would be in contact with the mat when modified as taught by Wiener. In regard to claim 8, Wiener shows in figure 1 the idea of using different sized pictures based upon the different sized openings and some of the openings are approximately four times the size of another opening. In view of the teachings of Wiener it would have been obvious to one in the art to modify Cook by making the pieces of art in different sizes since this would allow a wide variety of differently sized pieces to be displayed at the same time and would allow certain pictures to be highlighted based upon their larger size. As broadly defined in claim 8, the larger piece of art is considered to a "print". In regard to claim 10, Cook shows a transparent protective means (2). In regard to claim 11, Cook shows in figures 1-4 a partially transparent piece (3) and an opaque piece (6). Cook shows in figure 4 a securing means (12). The backing (4) is considered to include a third opening (the entire backing is translucent so it allows light to pass through so as broadly defined, the entire portion of 4 inside the flanges 11 is considered to be an opening, i.e. allows light to pass through and allows a person to see through it). In regard to claim 14, Cook discloses the use of clamping devices (12) but does not disclose the use of an adhesive. Wiener

Art Unit: 3611

discloses in column 2, lines 60-63 the idea of using glue. In view of the teachings of Wiener it would have been obvious to one in the art to modify Cook by using an adhesive since this would allow the panels to be secured in a better manner. In regard to claim 17, since the member (6) has a thickness it is considered to be three dimensional. In regard to claim 18, Cook shows in figure 1 that the frame includes two short frame elements and two long frame elements and a transparent cover (2).

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook (U.S. Patent No. 2,902,787) in view of Wiener (U.S. Patent No. 4,899,473) as applied to claim 2 above and further in view of Ross (U.S. Patent No. 4,748,756).

Cook in view of Wiener disclose the applicant's basic inventive concept except for using a battery to power the light source. Ross shows in figure 8 batteries (52) used to power the lights for a frame. In view of the teachings of Ross it would have been obvious to one in the art to modify Cook by attaching batteries to the display since this would allow the frame assembly to be used in a wider range of locations. In regard to claim 5, Cook does not disclose using a fluorescent light source. Ross shows in figure 8 a fluorescent light source (60). In view of the teachings of Ross it would have been obvious to one in the art to modify Cook by replacing the light source with a fluorescent light source since this would reduce the amount of power consumed by the light source and reduce the amount of heat generated.

Art Unit: 3611

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cook (U.S. Patent No. 2,902,787) in view of Wiener (U.S. Patent No. 4,899,473) as applied to claim 6 above and further in view of Gallagher (U.S. Patent No. 5,546,685).

Cook in view of Wiener disclose the applicant's basic inventive concept except for providing transparent pieces on opposite sides of the transparent art piece. Gallagher shows in figure 3 an art piece (112) which includes transparent pieces (114) on opposite sides of the art piece. In view of the teachings of Gallagher it would have been obvious to one in the art to modify Cook by placing transparent pieces on opposite sides of the piece of art since this would allow the piece of art to be better protected.

Allowable Subject Matter

Claims 12,13,15, and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and correcting the objections in these claims.

Claims 19 and 20 are allowable except for the objections appearing in these claims.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Liao teaches the use of a frame including a backing having an opening which receives a light source therein. Royal shows in figures 1-3 a print (19) and a transparent panel (15) with indicia thereon. Luray, Ne Page, and Carter teach the use of illuminated displays.

Art Unit: 3611

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
Aug. 16, 2004